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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,229	06/19/2001	Mohamed Kanji	05725.0537-00	9812
22852	7590	10/15/2003	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 1300 I STREET, NW WASHINGTON, DC 20005			VENKAT, JYOTHSNA A	
			ART UNIT	PAPER NUMBER
			1615	15
DATE MAILED: 10/15/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,229

Applicant(s)

KANJI ET AL.

Examiner

JYOTHSNA A VENKAT

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-118 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-66, 70-101 and 104-118 is/are rejected.
- 7) ☒ Claim(s) 67-69, and 102-103 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

Receipt is acknowledged of amendment a, response and extension of time filed on 3/12/03, 3/24/03 and 1/23/02.

Claims 1-118 are pending in the application and the status of the application is as follows:

The following rejections are maintained for reasons of record.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 16,31,50,65,85,99, and 118 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression “*derivatives of any of the forgoing*” is without metes and bounds. Applicants are claiming various components that are to be added in the cosmetic formulations. Recourse to the specification does not define “*derivative*” for any single compound. Let alone all the compounds claimed (claims 16,31,50,85,99, and 118).

ARGUMENTS

3. Applicant's arguments filed 9/4/03 have been fully considered but they are not persuasive.

Applicants argue that one of ordinary skill in the art would recognize that at least one additional ingredient may be chosen from the recited ingredients and any compound or obtained from the recited ingredients which contain the essential elements of the recited ingredients.

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In response to the above argument, it is the position of the examiner, that the metes and bounds of the term cannot be determined. Note that there are many functional groups in any given molecule and once the compound is derivatized the functional property changes. Applicants in the specification did not describe one compound under derivative for each listed ingredients, so that one of ordinary skill in the art would recognize the ingredient. Therefore the metes and bound of this term cannot be determined from the disclosure.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-66, 70-101, and 104-118 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of JP abstract 5025019('019), U.S. Patents 5,959,009('009) and 5,756,082('082).

The instant application is claiming compositions comprising:

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1) *Polymethylsilsesquioxane*

2) *Film former, which is different than the component one. The species are various styrene block copolymers*

3) *Various additives*

The claims are drawn to compositions or emulsions and these compositions are useful in lipsticks, mascara and eyeliners.

The patents '009 and '082 teach components 2-3 in cosmetic compositions. See col.2, lines 1-15 and see the examples ('009) and see col.2, lines 30-50('082). The film formers are used in cosmetic compositions to form a film so that it repels water as water and polymers are not miscible. The patents do not teach component 1. However the abstract teaches polymethyl silsesquioxanes in cosmetic compositions. The polymer has high water and oil repellency

Accordingly it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of '009 or '082 and combine it with the *polymethyl silsesquioxanes of the abstract* expecting beneficial effect to the cosmetic compositions. The motivation to use the *polymethyl silsesquioxanes* in the compositions stems from the teachings of the abstract that this polymer used in the cosmetic material has high resistance to water. The idea of combining the ingredients flows logically from the art for having been used in the same cosmetic compositions. This is prima facie case of obviousness.

ARGUMENTS

7. Applicant's arguments filed 9/4/03 have been fully considered but they are not persuasive.

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The gist of applicant's argument is that JP '019 discloses a cosmetic powder consisting of spherical polymer powder where in the polymer powder is one or mixture of Polymethylsilsesquioxane, but the specification at paragraph 14 at page 11 of the specification teaches that not all polydimethylsilsesquioxanes are film formers and therefore the JP fails to teach or suggest the claimed polydimethylsilsesquioxanes as the film former.

8. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. the structures on pages 12-13 which are the film formers claimed in the instant application) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Allowable Subject Matter

9. Claims 67-69, and 102-103 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37


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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 703-308-2439. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 703-308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


JYOTHSNA A VENKAT
Primary Examiner
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